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BORISSOV, IGOR N

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/628,496
Filing Date: July 28, 2000
Appellant(s): BRESNAN ET AL.

Brian A. Lemm
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/13/2010 appealing from the Office action mailed 02/18/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-21, 23-40 and 42-52

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-21, 23-29, 32, 34, 37-40, 42, 43, 47, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al. (EP 0719 597) in view of Humes et al. (US 5,377,120).

Independent Claims

Claim 1.

Cordery et al. (Corderly) teaches a method of defining and producing a finished mail piece, comprising the steps of:

(a) selecting at a first node (Fig. 3, Host Computer 52), a plurality of characteristics which together define a mailing (C. 3, L. 2-9; C. 3, L. 59 - C. 4, L. 14);

(b) creating a document and storing said document in electronic form, then directing that said stored document be included in a print job comprising said mailing (C. 3, L. 40 - C. 4. L. 6);

(c) creating an address list comprising one or more destination addresses and storing said address list in electronic form and then selecting said stored address list for inclusion in said print job (C. 3, L. 49-53, 59 - C. 4. L. 12);

(d) transmitting electronically said print job to a terminal node (a controller of Apparatus 50; C. 6, L. 20-29; C. 4, L. 36-38);

(e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing

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said mail piece (C. 4, L. 36-38; C. 6, L. 20-29), said mail production means further comprising:

- (i) a first printer (C. 5, L. 5);
- (ii) a second printer (C. 4, L. 38-39);
- (f) printing on said first printer said destination address to an envelope wherein each of said destination addresses is printed to a corresponding envelope (C. 5, L. 5-10);
- (g) printing on said second printer said document, wherein said document is printed in accordance with characteristics selected at said first node (C. 4, L. 38-45);
- (h) inserting said printed document into said printed envelope to form an unfinished mail piece (C. 5, L. 54-56);
- (i) sealing said unfinished mail piece (C. 5, L. 57 - C. 6, L. 3);
- (j) franking said unfinished mail piece, in accordance with characteristics selected at said first node and with characteristics determined at said second node, in order to form a finished mail piece (C. 6, L. 8-9);
- (k) placing said finished mail piece into a mail stream for delivery to said destination address printed thereon (C. 6, L. 8-9).

While it appears that said terminal node (a controller of Apparatus 50), to which said print job is transmitted, is not co-located with, nor under the control of, said first node (Host Computer 52), Cordery does not explicitly teach that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node.

Humes et al. (Humes) teaches a method of defining and producing a finished mail piece, wherein a third party, other the source of the mailing data/items, uses a computer system which is not co-located with, nor under the control of, the computer that is the source of the mailing data/items, to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third independent party may

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include the third independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system (C. 3, L. 30-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery to include that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node, as disclosed in Humes, because it would advantageously allow to achieve lower mailing costs to a mailer, as specifically stated in Humes (C. 3, L. 48).

Claim 15.

Cordery teaches a system for producing a mail piece comprising:

(a) first data processing means for selecting a document, selecting an address list, and selecting a plurality of characteristics which together define a mailing (Fig. 3, Host Computer 52; C. 3, L. 2-9, 49-53; C. 3, L. 59 - C. 4, L. 14);

(b) transmission means for transmitting said mailing to a second data processing means (C. 4, L. 36-38);

(c) second data processing means for receiving said mailing and downloading said mailing to a plurality of printer means comprising a first printer and a second printer (a controller of Apparatus 50; C. 6, L. 20-29; C. 4, L. 36-38);

(d) first printer means comprising said first printer for printing addresses from said address list to envelopes (C. 5, L. 5);

(e) second printer means comprising said second printer for printing said document to media selected at said first data processing means (C. 4, L. 38-39);

(f) inserter means for inserting said printed documents into said envelopes to form an unfinished mail piece (C. 5, L. 54-56);

(g) sealing means for sealing said unfinished mail piece (C. 5, L. 37 - C. 6, L. 3);

(h) franking means for franking said unfinished mail piece to form a finished mail piece (C. 6, L. 8-9).

While it is appears that said second data processing means (a controller or any part of Apparatus 50; C. 6, L. 20-29), to which said mailing is transmitted, is not co-located with, nor under the control of, said first data processing means (Host Computer 52), Cordery does not explicitly teach that second data processing means, to which said mailing is transmitted, is not co-located with, nor under the control of, said first data processing means.

Humes teaches a method of defining and producing a finished mail piece, wherein a third party, other the source of the mailing data/items, uses a computer system which is not co-located with, nor under the control of, the computer that is the source of the mailing data/items, to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third independent party may include the third independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system (C. 3, L. 30-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery to include that second data processing means, to which said mailing is transmitted, is not co-located with, nor under the control of, said first node, as disclosed in Humes, because it would advantageously allow to achieve lower mailing costs to a mailer, as specifically stated in Humes C. 3, L. 48).

Claim 20.

Cordery teaches a method of defining and producing a finished mail piece, comprising the steps of:

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selecting at a first node (Fig. 3, Host Computer 52) a plurality of characteristics which define a mailing (C. 3, L. 2-9; C. 3, L. 59 - C. 4, L. 14);

creating a document and storing said document in electronic form (C. 3, L. 40 - C. 4, L. 6);

creating an address list comprising one or more destination addresses and storing said address list in electronic form (C. 3, L. 49-53, 59 - C. 4, L. 12);

transmitting said document, said address list and said characteristics to a terminal node (a controller of Apparatus 50; C. 6, L. 20-29; C. 4, L. 36-38);

receiving said document, said address list and said characteristics at said terminal node and directing said document, said address list and said characteristics to a mail production means (C. 4, L. 36-38; C. 6, L. 20-29);

printing each of said destination addresses to a corresponding envelope (C. 5, L. 5-10);

printing said document in accordance with one or more of said characteristics selected at said first node (C. 4, L. 38-45);

inserting said printed document into a corresponding printed envelope to form the mail piece (C. 5, L. 54-56);

providing said printed envelope with evidence of postage payment (franking suggests this feature) (C. 6, L. 8-9);

placing the mail piece into a mail stream for delivery to said destination address printed thereon (C. 6, L. 8-9).

While it appears that said terminal node (a controller of Apparatus 50), to which said print job is transmitted, is not co-located with, nor under the control of, said first node (Host Computer 52), Cordery does not explicitly teach that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node.

Humes teaches a method of defining and producing a finished mail piece, wherein a third party, other the source of the mailing data/items, uses a computer system which is not co-located with, nor under the control of, the computer that is the source of the mailing data/items, to collect mailing data that defines item of mail from a

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number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third independent party may include the third independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system (C. 3, L. 30-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery to include that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node, as disclosed in Humes, because it would advantageously allow to achieve lower mailing costs to a mailer, as specifically stated in Humes (C. 3, L. 48).

Claim 38.

Cordery teaches a system for producing a mail piece comprising:

first data processing means for selecting a document, selecting an address list including one or more destination addresses, and selecting a plurality of characteristics which define a mailing (Fig. 3, Host Computer 52; C. 3, L. 2-9, 49-53; C. 3, L. 59 - C. 4, L. 14);

second data processing means for electronically receiving said selected document, address list and characteristics and directing said selected document, address list and characteristics to a mail production means (a controller of Apparatus 50; C. 6, L. 20-29; C. 4, L. 36-39; C. 5, L. 5);

said mail production means comprising first means for printing said selected document in accordance with one or more of said selected characteristics (C. 4, L. 38-39), second means for printing each of said destination addresses to a corresponding envelope (C. 5, L. 5), means for printing said corresponding envelope with evidence of

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postage payment (franking suggests this feature) (C. 6, L. 8-9); and means for inserting said printed document into a corresponding printed envelope (C. 5, L. 54-56).

While it is appears that said second data processing means (a controller of Apparatus 50) is not co-located with, nor under the control of, said first data processing means (Host Computer 52), Cordery does not explicitly teach that second data processing means is not co-located with, nor under the control of, said first data processing means.

Humes teaches a method of defining and producing a finished mail piece, wherein a third party, other the source of the mailing data/items, uses a computer system which is not co-located with, nor under the control of, the computer that is the source of the mailing data/items, to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third independent party may include the third independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system (C. 3, L. 30-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery to include that said second data processing means is not co-located with, nor under the control of, said first data processing means, as disclosed in Humes, because it would advantageously allow to achieve lower mailing costs to a mailer, as specifically stated in Humes (C. 3, L. 48).

Dependent Claims

Claim 5. Humes teaches said method of claim 1 wherein a receipt (invoices) indicative of said print job and delivery into said mail stream is generated by said terminal node and transmitted to said first node (C. 3, L. 53-55). The motivation to

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combine the references would be to obtain saving through the service of a third party service provider.

Claim 6. Cordery teaches said method of claim 1, wherein said first printer and said second printer are co-located within a single apparatus (Fig. 3, items 56 and 66).

Claim 7. Cordery teaches said method of claim 6, wherein said apparatus is a mailing system comprising: (a) a data processor; (b) a document printer; (c) an envelope printer; (e) an inserter (see reasoning applied to claim 1).

Cordery does not explicitly teach: (d) a postage meter. However, Cordery discloses that after the completed mail piece has been generated, the mail piece is franked and placed in the postal system for delivery (C. 6, L. 8-9). Since, the function of franking an item of mail commonly requires a postage meter or a system that provides the equivalent function/system of a postage meter, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Cordery includes a postage meter for the benefit of producing a finished mail piece.

Claims 8-10. Cordery in view of Humes teach all limitations of claims 8-10, except specifically teaching that said terminal node is the next consecutive node after said first node; or that said first node selects said terminal node from among a plurality of terminal nodes; or that said first node selects said second node as determined by said second node being a first available terminal node in accordance with a predetermined order of terminal nodes.

However, Cordery in view of Humes requires the transmission of the mailing data from one node to the next one without restricting the type of communication path being used. Furthermore, Specification does not provide any indication of advantages or unexpected results from practicing said node arrangement. Without providing said indication of advantages or unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in

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view of Humes to include any node arrangement suitable for the job for the benefit of producing a finished mail piece.

Claims 11-14 and 18-19. Same reasoning as applied to claims 8-10.

Claim 16. Cordery teaches that said second data processing means, said second printer means, said inserter means, and said sealing means, comprise a single apparatus (Fig. 3).

Cordery does not explicitly teach that said single apparatus comprises said franking means.

However, Cordery discloses that after the completed mail piece has been generated, the mail piece is franked and placed in the postal system for delivery (C. 6, L. 8-9). Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the mail to modify Cordery to include that said single apparatus comprises said franking means for the benefit of producing a finished mail piece.

Claim 17. Cordery teaches the system of claim 15, wherein said first printer means and said second printer means are co-located (Fig. 3, items 56 and 66).

Claims 21, 25 and 40. Humes teaches said method according to claim 20, including providing the evidence of postage payment (C. 3, L. 53-55). The motivation to combine the references would be to obtain saving through the service of a third party service provider. Furthermore, so as mail item characteristics including the size, shape, and weight affect the required postage, it would have been obvious to one of ordinary skill at the time the invention was made to modify the mail processing systems of Cordery and Humes to include that said evidence of postage payment is in accordance with one or more of said characteristics selected at said first node for the benefit of applying correct charge.

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Claims 23, 27 and 42. So as mail item characteristics including the size, shape, and weight affect the required postage, it would have been obvious to one of ordinary skill at the time the invention was made to modify the mail processing systems of Cordery to include considering the characteristics of the item of mail when determining the required postage for the benefit of applying correct charge.

Claim 24. Cordery teaches the method according to claim 20, further comprising sealing said corresponding printed envelope after said inserting step (C. 5, L. 57 - C. 6, L. 3).

Claim 26. Humes teaches said method according to claim 20, including providing the evidence of postage payment (C. 3, L. 53-55). The motivation to combine the references would be to obtain saving through the service of a third party service provider.

Claims 28 and 29. Cordery in view of Humes teaches all limitations of claims 28-29, except specifically teaching that said document, said address list and said characteristics are transmitted independent of one another, or concurrently.

However, Cordery in view of Humes requires the transmission of said data from one node to the next one without indication of any restrictions or conditions. Furthermore, Specification does not provide any indication of advantages or unexpected results from practicing said inventive feature. Without providing said indication of advantages or unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include that said document, said address list and said characteristics are transmitted independent of one another, or concurrently for the job for the benefit of producing a finished mail piece.

Claim 32. So as a class of postage for the mail piece affect the required postage, it would have been obvious to one of ordinary skill at the time the invention was made to

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modify the mail processing systems of Cordery in view of Humes to include considering the class of postage for the mail piece when selecting said characteristics.

Claims 37 and 47. Humes teaches generating invoices for printed and processed mail (C. 3, L. 50-55), thereby suggesting providing an indication to said first node that said mail piece has been placed into the mail stream for delivery.

Claim 39. Cordery teaches the system according to claim 38, said mail production means further comprising means for sealing the corresponding printed envelope (Fig. 3, item 90).

Claim 43. Said system according to claim 38, wherein said document and said address list are stored in electronic form (same reasoning as applied to claim 38).

Claim 51. So as permit mail is a way to pay for postage, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include that said evidence of postage is a permit mail postal indicia for the benefit of providing evidence of postage for high volume mailings.

Claim 52. Cordery teaches franking sealed envelope (C. 6, L. 8-9), thereby suggesting obtaining a postal indicia, which is the evidence of postage and the amount of postage that has been paid.

Claims 2, 30, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al. in view of Humes et al. further in view of Seki et al. (US 5,121,195) and further in view of Lombardo (US 5,346,123).

Dependent Claims

Claims 2, 30, 31 and 33. Cordery in view of Humes teaches all the limitations of claims 2, 30, 31 and 33, except that said plurality of characteristics comprises:

- (a) a choice of paper, said choice further comprising:
 - (i) a choice of ink color,
 - (ii) a choice of paper color;
 - (iii) a choice of paper size;
- (b) a choice of duplex or simplex printing on said chosen paper;
- (c) a choice of whether or not a reply envelope is to be printed; and
- (d) a choice of how said chosen paper is to be folded.

Seki et al. (Seki) teaches printing method and system, wherein a type, size and color of paper and color of ink is selected during the printing.

Lombardo teaches a method for printing a business form, wherein duplex or simplex printing mode as well as folding operations and a reply envelope printing are considered.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include that said plurality of characteristics comprises a type, size and color of paper and color of ink, as disclosed in Seki, and duplex or simplex printing mode, folding operations and a reply envelope printing, as suggested in Lombardo, because it would advantageously allow to enhance the system functionalities, thereby providing convenience to the customers.

Claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al. in view of Humes et al. further in view of Rosenbaum et al. (US 5,031,223).

Claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50. Cordery in view of Humes teaches all limitations of claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50, except that said each of said destination addresses comprising said stored address list is compared to a predetermined database of correct addresses wherein each address is matched with a corresponding zip code, and if said each of said destination addresses does not match

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said correct address then said non-matching address is corrected to match said correct address.

Rosenbaum et al. (Rosenbaum) teaches a method and system for mail processing, wherein obtained address information of mail items is compared to that stored in a database, and if obtained address is not matched with proper data, the obtained address is corrected (C. 10, L. 67 - C. 11, L. 68).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include address hygiene technique, as disclosed in Rosenbaum, because it would advantageously allow to ensure that mail reaches the recipients.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

| | | |
|--------------|------------------|----------------|
| EP 0719 597 | Cordery et al. | March 07, 1996 |
| US 5,377,120 | Humes et al. | Dec. 27, 1994 |
| US 5,121,195 | Seki et al. | June 9, 1992 |
| US 5,346,123 | Lombardo | Sep. 13, 1994 |
| US 5,031,223 | Rosenbaum et al. | Jul. 9, 1991 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The instant application is a reissue of 08/772,787, now U.S. Patent 5,873,073, filed 12/24/1996. Therefore, for the purposes of examination, the effective date of the present application is determined as 12/24/1996.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5-21, 23-29, 32, 34, 37-40, 42, 43, 47, 51 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al. (EP 0719 597) in view of Humes et al. (US 5,377,120).

Independent Claims

Claim 1.

Cordery et al. (Corderly) teaches a method of defining and producing a finished mail piece, comprising the steps of:

(a) selecting at a first node (Fig. 3, Host Computer 52), a plurality of characteristics which together define a mailing (C. 3, L. 2-9; C. 3, L. 59 - C. 4, L. 14);

(b) creating a document and storing said document in electronic form, then directing that said stored document be included in a print job comprising said mailing (C. 3, L. 40 - C. 4, L. 6);

(c) creating an address list comprising one or more destination addresses and storing said address list in electronic form and then selecting said stored address list for inclusion in said print job (C. 3, L. 49-53, 59 - C. 4, L. 12);

(d) transmitting electronically said print job to a terminal node (a controller of Apparatus 50; C. 6, L. 20-29; C. 4, L. 36-38);

(e) receiving said print job at said terminal node, said terminal node for receiving said print job and for directing said print job to a mail production means for producing said mail piece (C. 4, L. 36-38; C. 6, L. 20-29), said mail production means further comprising:

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(i) a first printer (C. 5, L. 5);

(ii) a second printer (C. 4, L. 38-39);

(f) printing on said first printer said destination address to an envelope wherein each of said destination addresses is printed to a corresponding envelope (C. 5, L. 5-10);

(g) printing on said second printer said document, wherein said document is printed in accordance with characteristics selected at said first node (C. 4, L. 38-45);

(h) inserting said printed document into said printed envelope to form an unfinished mail piece (C. 5, L. 54-56);

(i) sealing said unfinished mail piece (C. 5, L. 57 - C. 6, L. 3);

(j) franking said unfinished mail piece, in accordance with characteristics selected at said first node and with characteristics determined at said second node, in order to form a finished mail piece (C. 6, L. 8-9);

(k) placing said finished mail piece into a mail stream for delivery to said destination address printed thereon (C. 6, L. 8-9).

While it is appears that said terminal node (a controller of Apparatus 50), to which said print job is transmitted, is not co-located with, nor under the control of, said first node (Host Computer 52), Cordery does not explicitly teach that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node.

Humes et al. (Humes) teaches a method of defining and producing a finished mail piece, wherein a third party, other the source of the mailing data/items, uses a computer system which is not co-located with, nor under the control of, the computer that is the source of the mailing data/items, to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third independent party may include the third independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the

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sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system (C. 3, L. 30-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery to include that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node, as disclosed in Humes, because it would advantageously allow to achieve lower mailing costs to a mailer, as specifically stated in Humes (C. 3, L. 48).

Claim 15.

Cordery teaches a system for producing a mail piece comprising:

(a) first data processing means for selecting a document, selecting an address list, and selecting a plurality of characteristics which together define a mailing (Fig. 3, Host Computer 52; C. 3, L. 2-9, 49-53; C. 3, L. 59 - C. 4, L. 14);

(b) transmission means for transmitting said mailing to a second data processing means (C. 4, L. 36-38);

(c) second data processing means for receiving said mailing and downloading said mailing to a plurality of printer means comprising a first printer and a second printer (a controller of Apparatus 50; C. 6, L. 20-29; C. 4, L. 36-38);

(d) first printer means comprising said first printer for printing addresses from said address list to envelopes (C. 5, L. 5);

(e) second printer means comprising said second printer for printing said document to media selected at said first data processing means (C. 4, L. 38-39);

(f) inserter means for inserting said printed documents into said envelopes to form an unfinished mail piece (C. 5, L. 54-56);

(g) sealing means for sealing said unfinished mail piece (C. 5, L. 37 - C. 6, L. 3);

(h) franking means for franking said unfinished mail piece to form a finished mail piece (C. 6, L. 8-9).

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While it appears that said second data processing means (a controller or any part of Apparatus 50; C. 6, L. 20-29), to which said mailing is transmitted, is not co-located with, nor under the control of, said first data processing means (Host Computer 52), Cordery does not explicitly teach that second data processing means, to which said mailing is transmitted, is not co-located with, nor under the control of, said first data processing means.

Humes teaches a method of defining and producing a finished mail piece, wherein a third party, other the source of the mailing data/items, uses a computer system which is not co-located with, nor under the control of, the computer that is the source of the mailing data/items, to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third independent party may include the third independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system (C. 3, L. 30-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery to include that second data processing means, to which said mailing is transmitted, is not co-located with, nor under the control of, said first node, as disclosed in Humes, because it would advantageously allow to achieve lower mailing costs to a mailer, as specifically stated in Humes C. 3, L. 48).

Claim 20.

Cordery teaches a method of defining and producing a finished mail piece, comprising the steps of:

selecting at a first node (Fig. 3, Host Computer 52) a plurality of characteristics which define a mailing (C. 3, L. 2-9; C. 3, L. 59 - C. 4, L. 14);

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creating a document and storing said document in electronic form (C. 3, L. 40 - C. 4. L. 6);

creating an address list comprising one or more destination addresses and storing said address list in electronic form (C. 3, L. 49-53, 59 - C. 4. L. 12);

transmitting said document, said address list and said characteristics to a terminal node (a controller of Apparatus 50; C. 6, L. 20-29; C. 4, L. 36-38);

receiving said document, said address list and said characteristics at said terminal node and directing said document, said address list and said characteristics to a mail production means (C. 4, L. 36-38; C. 6, L. 20-29);

printing each of said destination addresses to a corresponding envelope (C. 5, L. 5-10);

printing said document in accordance with one or more of said characteristics selected at said first node (C. 4, L. 38-45);

inserting said printed document into a corresponding printed envelope to form the mail piece (C. 5, L. 54-56);

providing said printed envelope with evidence of postage payment (franking suggests this feature) (C. 6, L. 8-9);

placing the mail piece into a mail stream for delivery to said destination address printed thereon (C. 6, L. 8-9).

While it is appears that said terminal node (a controller of Apparatus 50), to which said print job is transmitted, is not co-located with, nor under the control of, said first node (Host Computer 52), Cordery does not explicitly teach that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node.

Humes teaches a method of defining and producing a finished mail piece, wherein a third party, other the source of the mailing data/items, uses a computer system which is not co-located with, nor under the control of, the computer that is the source of the mailing data/items, to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail

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document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third independent party may include the third independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system (C. 3, L. 30-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery to include that said terminal node, to which said print job is transmitted, is not co-located with, nor under the control of, said first node, as disclosed in Humes, because it would advantageously allow to achieve lower mailing costs to a mailer, as specifically stated in Humes (C. 3, L. 48).

Claim 38.

Cordery teaches a system for producing a mail piece comprising:

first data processing means for selecting a document, selecting an address list including one or more destination addresses, and selecting a plurality of characteristics which define a mailing (Fig. 3, Host Computer 52; C. 3, L. 2-9, 49-53; C. 3, L. 59 - C. 4, L. 14);

second data processing means for electronically receiving said selected document, address list and characteristics and directing said selected document, address list and characteristics to a mail production means (a controller of Apparatus 50; C. 6, L. 20-29; C. 4, L. 36-39; C. 5, L. 5);

said mail production means comprising first means for printing said selected document in accordance with one or more of said selected characteristics (C. 4, L. 38-39), second means for printing each of said destination addresses to a corresponding envelope (C. 5, L. 5), means for printing said corresponding envelope with evidence of postage payment (franking suggests this feature) (C. 6, L. 8-9); and means for inserting said printed document into a corresponding printed envelope (C. 5, L. 54-56).

While it appears that said second data processing means (a controller of Apparatus 50) is not co-located with, nor under the control of, said first data processing means (Host Computer 52), Cordery does not explicitly teach that second data processing means is not co-located with, nor under the control of, said first data processing means.

Humes teaches a method of defining and producing a finished mail piece, wherein a third party, other the source of the mailing data/items, uses a computer system which is not co-located with, nor under the control of, the computer that is the source of the mailing data/items, to collect mailing data that defines item of mail from a number of different mailers/sources. The collected mail data is then used to produce a finished item of mail in accordance with the mailing data, i.e. mail characteristics, mail document data and destination data, as sent from the source of the mail data/items. The production of a finished item by the third independent party may include the third independent party combining/merging documents from a number of mail sources into a single item of mail based on one or more mailing lists from the sources of the mailing data/item. The independent third party would then produce a merged mailing by printing the combined document data based on the mailing lists to create a finished item of mail that will be placed into mail stream of the postal system (C. 3, L. 30-49).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery to include that said second data processing means is not co-located with, nor under the control of, said first data processing means, as disclosed in Humes, because it would advantageously allow to achieve lower mailing costs to a mailer, as specifically stated in Humes (C. 3, L. 48).

Dependent Claims

Claim 5. Humes teaches said method of claim 1 wherein a receipt (invoices) indicative of said print job and delivery into said mail stream is generated by said terminal node and transmitted to said first node (C. 3, L. 53-55). The motivation to combine the references would be to obtain saving through the service of a third party service provider.

Claim 6. Cordery teaches said method of claim 1, wherein said first printer and said second printer are co-located within a single apparatus (Fig. 3, items 56 and 66).

Claim 7. Cordery teaches said method of claim 6, wherein said apparatus is a mailing system comprising: (a) a data processor; (b) a document printer; (c) an envelope printer; (e) an inserter (see reasoning applied to claim 1).

Cordery does not explicitly teach: (d) a postage meter. However, Cordery discloses that after the completed mail piece has been generated, the mail piece is franked and placed in the postal system for delivery (C. 6, L. 8-9). Since, the function of franking an item of mail commonly requires a postage meter or a system that provides the equivalent function/system of a postage meter, it would have been obvious to one of ordinary skill at the time the invention was made that the mail processing systems of Cordery includes a postage meter for the benefit of producing a finished mail piece.

Claims 8-10. Cordery in view of Humes teach all limitations of claims 8-10, except specifically teaching that said terminal node is the next consecutive node after said first node; or that said first node selects said terminal node from among a plurality of terminal nodes; or that said first node selects said second node as determined by said second node being a first available terminal node in accordance with a predetermined order of terminal nodes.

However, Cordery in view of Humes requires the transmission of the mailing data from one node to the next one without restricting the type of communication path being used. Furthermore, Specification does not provide any indication of advantages or unexpected results from practicing said node arrangement. Without providing said indication of advantages or unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include any node arrangement suitable for the job for the benefit of producing a finished mail piece.

Claims 11-14 and 18-19. Same reasoning as applied to claims 8-10.

Claim 16. Cordery teaches that said second data processing means, said second printer means, said inserter means, and said sealing means, comprise a single apparatus (Fig. 3).

Cordery does not explicitly teach that said single apparatus comprises said franking means.

However, Cordery discloses that after the completed mail piece has been generated, the mail piece is franked and placed in the postal system for delivery (C. 6, L. 8-9). Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the mail to modify Cordery to include that said single apparatus comprises said franking means for the benefit of producing a finished mail piece.

Claim 17. Cordery teaches the system of claim 15, wherein said first printer means and said second printer means are co-located (Fig. 3, items 56 and 66).

Claims 21, 25 and 40. Humes teaches said method according to claim 20, including providing the evidence of postage payment (C. 3, L. 53-55). The motivation to combine the references would be to obtain saving through the service of a third party service provider. Furthermore, so as mail item characteristics including the size, shape, and weight affect the required postage, it would have been obvious to one of ordinary skill at the time the invention was made to modify the mail processing systems of Cordery and Humes to include that said evidence of postage payment is in accordance with one or more of said characteristics selected at said first node for the benefit of applying correct charge.

Claims 23, 27 and 42. So as mail item characteristics including the size, shape, and weight affect the required postage, it would have been obvious to one of ordinary skill at the time the invention was made to modify the mail processing systems of

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Cordery to include considering the characteristics of the item of mail when determining the require postage for the benefit of applying correct charge.

Claim 24. Cordery teaches the method according to claim 20, further comprising sealing said corresponding printed envelope after said inserting step (C. 5, L. 57 - C. 6, L. 3).

Claim 26. Humes teaches said method according to claim 20, including providing the evidence of postage payment (C. 3, L. 53-55). The motivation to combine the references would be to obtain saving through the service of a third party service provider.

Claims 28 and 29. Cordery in view of Humes teaches all limitations of claims 28-29, except specifically teaching that said document, said address list and said characteristics are transmitted independent of one another, or concurrently.

However, Cordery in view of Humes requires the transmission of said data from one node to the next one without indication of any restrictions or conditions. Furthermore, Specification does not provide any indication of advantages or unexpected results from practicing said inventive feature. Without providing said indication of advantages or unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include that said document, said address list and said characteristics are transmitted independent of one another, or concurrently for the job for the benefit of producing a finished mail piece.

Claim 32. So as a class of postage for the mail piece affect the required postage, it would have been obvious to one of ordinary skill at the time the invention was made to modify the mail processing systems of Cordery in view of Humes to include considering the class of postage for the mail piece when selecting said characteristics.

Claims 37 and 47. Humes teaches generating invoices for printed and processed mail (C. 3, L. 50-55), thereby suggesting providing an indication to said first node that said mail piece has been placed into the mail stream for delivery.

Claim 39. Cordery teaches the system according to claim 38, said mail production means further comprising means for sealing the corresponding printed envelope (Fig. 3, item 90).

Claim 43. Said system according to claim 38, wherein said document and said address list are stored in electronic form (same reasoning as applied to claim 38).

Claim 51. So as permit mail is a way to pay for postage, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include that said evidence of postage is a permit mail postal indicia for the benefit of providing evidence of postage for high volume mailings.

Claim 52. Cordery teaches franking sealed envelope (C. 6, L. 8-9), thereby suggesting obtaining a postal indicia, which is the evidence of postage and the amount of postage that has been paid.

Claims 2, 30, 31 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al. in view of Humes et al. further in view of Seki et al. (US 5,121,195) and further in view of Lombardo (US 5,346,123).

Dependent Claims

Claims 2, 30, 31 and 33. Cordery in view of Humes teaches all the limitations of claims 2, 30, 31 and 33, except that said plurality of characteristics comprises:

(a) a choice of paper, said choice further comprising:

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- (i) a choice of ink color,
- (ii) a choice of paper color;
- (iii) a choice of paper size;
- (b) a choice of duplex or simplex printing on said chosen paper;
- (c) a choice of whether or not a reply envelope is to be printed; and
- (d) a choice of how said chosen paper is to be folded.

Seki et al. (Seki) teaches printing method and system, wherein a type, size and color of paper and color of ink is selected during the printing.

Lombardo teaches a method for printing a business form, wherein duplex or simplex printing mode as well as folding operations and a reply envelope printing are considered.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include that said plurality of characteristics comprises a type, size and color of paper and color of ink, as disclosed in Seki, and duplex or simplex printing mode, folding operations and a reply envelope printing, as suggested in Lombardo, because it would advantageously allow to enhance the system functionalities, thereby providing convenience to the customers.

Claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cordery et al. in view of Humes et al. further in view of Rosenbaum et al. (US 5,031,223).

Claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50. Cordery in view of Humes teaches all limitations of claims 3, 4, 34, 35, 36, 44, 45, 46, and 48-50, except that said each of said destination addresses comprising said stored address list is compared to a predetermined database of correct addresses wherein each address is matched with a corresponding zip code, and if said each of said destination addresses does not match said correct address then said non-matching address is corrected to match said correct address.

Rosenbaum et al. (Rosenbaum) teaches a method and system for mail processing, wherein obtained address information of mail items is compared to that stored in a database, and if obtained address is not matched with proper data, the obtained address is corrected (C. 10, L. 67 - C. 11, L. 68).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Cordery in view of Humes to include address hygiene technique, as disclosed in Rosenbaum, because it would advantageously allow to ensure that mail reaches the recipients.

(10) Response to Argument

Applicant argues that "there is (also) no disclosure, teaching or suggestion in Cordery of "franking said unfinished mail piece, in accordance with characteristics selected at said first node and with characteristics determined at said second node, in order to form a finished mail piece" as is recited in claim 1.

In response to this argument it is noted that Cordery discloses a first node (Fig. 3, Host Computer 52), and a terminal node (a controller of Apparatus 50; C. 6, L. 20-29). Cordery further discloses selecting mailing characteristics at said first node (C. 4, L. 36-38; C. 3, L. 40-52), transmitting said selected data from the first node (Host Computer 52) to the terminal node (C. 6, L. 20-29), and processing said data, or determining said characteristics, at the terminal node (C. 6, L. 30-42).

Specification teaches (C. 17, L. 11-19):

In FIG. 8B, there is shown a communications path where the initiating node is in direct communication with the terminal node, but the initiating and terminal nodes are in separate locations. At step 810, the initiating node would define the mailing parameters and transmit those parameters to the terminal node at step 812. At step 814, the terminal node would receive the mailing job, parse the instructions and then set-up the mailing for production. The method would complete the mailing production at step 816. 15

Cordery explicitly teaches said features. Cordery discloses the initiating node (Host Computer 52) which is in direct communication with the terminal node (C. 6, l. 20-29); the Host Computer 52 defines (selects) the mailing parameters (C. 4, L. 36-38; C. 3, L. 40-52) and transmits those parameters to the terminal node (C. 6, l. 20-29); the terminal node receives the mailing job, parses the instructions and then set-up the mailing for production (C. 6, L. 30-58).

Applicant argues that in Humes, a floppy disk containing an address list is input to the first computer 29 for merging with other address lists from other floppy disks. There is no device disclosed in Humes that corresponds to a *first node* at which a plurality of characteristics which together define a mailing is selected and a *terminal node* which is not co-located with, nor under the control of the first node. In Humes, both the first computer and second computer are co-located. There are no other devices disclosed in Humes that could correspond to the first node and terminal node as recited in claim 1.

In response to this argument it is noted that Humes teaches a method and system for defining and producing a finished mail piece, wherein a third party, other than the source of the mailing data/items (*merchants databases 23-26*), uses a computer system (including a computers 29, 57 and a printer 51) which is not co-located with, nor under the control of, *the computer that is the source of the mailing data/items*, to collect mailing data that defines item of mail from a number of different mailers/sources.

Figure 1 in Humes discloses said mailers/sources as *databases 23-26*, and further teaches that said *databases 23-26* “*illustrated as being stored on floppy disks*” (C. 4, L. 13-14), thereby disclosing merchants' *computer(s) or the first node* used to generate and store said address lists on said floppy disks. Humes further teaches that said databases 23-26 include address lists (*a plurality of characteristics*) for pieces to be mailed (C. 3, L. 34-36), thereby disclosing *a plurality of characteristics* (addresses in said lists), *which together define a mailing, selected* (to be included into said address lists) at said first node (merchants' *computers*).

Further, Humes teaches that said third party, other the source of the mailing data/items (other than said merchants' computer(s) or *the first node*), uses a computer system (including a computers 29, 57 and a printer 51) to collect mailing data that defines item of mail from a number of different mailers/sources (Figure 1, “29” and “57”), recognize (determine) each address for each item, determine grouping for addresses to obtain the lowest possible rate, determine additional addressing information necessary

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for each address for each item based on the lowest rate, and send processed items to the printer 51 (C. 4, L. 12-35; C. 3, L. 65-68; C. 6, L. 41-43). Humes specifically disclose a computer system (a *terminal node*) configured for receiving mailing data from a plurality of unpredetermined sources or merchants' computer(s) (*first nodes*) to group said data into grouped bundles to obtain low postal rates, said computer system or *terminal node* including computers 29, 57 and a printer 51, *which is not co-located with, nor under the control of said merchants' computer(s) (the first node(s))* used to generate merchants databases 23-26.

Applicant argues that, even if, (for arguments sake only), it is assumed that Humes does disclose a terminal node that is not co-located with, nor under the control of, a first node, combining Humes with Cordery to provide a first node and a terminal node that are not co-located directly contradicts one of the objects of the system described in Cordery, and specifically to provide an apparatus and method for producing moderately sized mail runs which is suitable for use in an office environment with standard microcomputers and word processing programs (Col. 1, line 56 - Col. 2, line 2). Separating the first node and terminal node such that they are not co-located would change the operating principle of being suitable for use in an office environment of the system of Cordery.

In response to this argument it is noted that “*an office environment with standard microcomputers and word processing programs*” may be understood as a plurality of computers located in an office, said office situated in several rooms of a building, or in a

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whole building, or an enterprise having offices located in different geographic areas.

Said "office environment" may simply include a plurality of workstations situated in various floors in a building or a campus connected to a single (group) printer, and such an arrangement is very well known. Both Cordery and Humes disclose a first computer (first node(s)) for selecting mailing characteristics, and a second computer (terminal node) for directing a print job. Accordingly, Humes, disclosing receiving data from a remote source (a merchant computer) and processing the received data to be printed, would not change the operating principle of Cordery's system.

Remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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